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OFFICE OF PETITIONS

In re Application of
Kohanek et al.
Application No.: 09/904,425
Filing or 371(c) Date: 07/12/2001
Attorney Docket Number 21223/0211061-US0

DECISION
ON PETITION

This is a decision on the petition under the unintentional provisions of 37 CFR 1.137(b), filed February 2, 2009, to revive the above-identified application. The delay in treating this petition is regretted.

This Petition is hereby **dismissed**.

Any further petition to revive the above-identified application must be submitted within TWO (2) MONTHS from the mail date of this decision. Extensions of time under 37 CFR 1.136(a) are permitted. The reconsideration request should include a cover letter entitled "Request for Reconsideration of Petition under [insert the applicable code section]". This is **not** final agency action within the meaning of 5 U.S.C. § 704.

The above-identified application became abandoned for failure to timely reply to the non-final Office action, mailed July 31, 2002. The Office action set a three (3) period for reply. Extensions of time under 37 CFR 1.136(a) were available. No reply having been received, the application became abandoned on November 1, 2002. A Notice of Abandonment was mailed March 26, 2003.

The present petition

1. Parties to the present petition

The application was filed on July 12, 2001, and included an oath/declaration executed by the inventors naming attorneys at the law firm of Reed Smith, LLP ("Reed Smith"), to prosecute the application. All telephone calls and correspondence were to be directed to Attorney Jules Goldberg at Reed Smith.

Assignments were recorded on March 11, 2002, assigning 50% interest in the application to Mitsubishi Materials Silicon Corporation, and 50% interest to Mitsubishi Silicon American Corporation. No new Power of Attorney was filed in the application until January 29, 2009. As such, at the time of the mailing of the Office action and Notice of Abandonment, attorneys in the law firm of Reed Smith LLP were the attorneys of record.

Through name changes and subsequent assignments of the application, SUMCO Corporation and SUMCO Phoenix Corporation are each current 50% owners of the present application. Each has executed a Power of Attorney appointing the law firm of Darby & Darby to prosecute the application, and the present petition is filed by Darby & Darby.

The petition provides that the Suda Patent Office ("SPO"), was the Japanese Patent Agent for the present application at the time of the mailing of the Office action and Notice of Abandonment. Office records reveal that the Office action and Notice of Abandonment were mailed to Reed Smith, and the Office action was subsequently received at SPO.

2. When Applicant became aware that the application was abandoned

Both Attorney Goldberg at Reed Smith and Ms. Suda at SPO provide that they learned that the application was abandoned in December, 2008, when as a result of the impending retirement of Attorney Goldberg, Mr. Suda requested a review of the applications entrusted to Mr. Goldberg. Petition at p.5. As a result of the review, Attorney Goldberg discovered and informed Mr. Suda that the present application is abandoned. Mr. Suda also provides that at that time Attorney Goldberg did not provide any reasons for the abandonment of the application. Petition at p.6.

3. SPO's docketing system

SPO provides that its docketing system, built in 1998, generally included Japanese applications only. Petition at p.7. In 1995 it's docketing system added information as to foreign applications, including mail dates of Office actions and response dates to office actions; however, Petitioner provides that the docketing system did NOT include data about the actual filing date of a response to foreign applications. Id., at p.8.

With regard to foreign applications, including those from this Office, SPO states that it usually translates into English the SUMCO IP Department's Japanese comments to SPO on those actions, and then sends English instructions to its foreign patent attorneys in light of the comments – usually two weeks before the actual due date of the response to the Office action. Petition at p.10.

Petitioner provides that following the mailing of the non-final Office action on July 3, 2002, "there were at least seven back and forth communications between SPO and the SUMCO IP Department." Id. at p.11. Petitioner also provides that "upon looking into the matter further as a result of the abandonment of the present application, SUMCO was not able to determine why the

IP department did not contact SPO concerning the applications until the December 12, 2008 date, when Mr. Suda notified the department of the abandonments.” Id. at p.17.

4. SUMCO’s Records

As noted supra, Petitioner provides that in the time period following the non-final Office action, there were at least seven back and forth communications between SPO and the SUMCO IP Department.

5. Reed Smith’s Records

Petitioner provides that Reed Smith’s records for the present application show that an attorney with the initials JG was assigned to the application, and that the non-final Office action and the Notice of Abandonment were mailed on July 3, 2002 and March 26, 2003 respectively. Id. at p.14. Petitioner also avers that Reed Smith’s records show a petition to revive the application was filed on February 6, 2003.

6. SPO’s Records

Petitioner provides that the last substantive communication in the SPO records for the present application was an October 17, 2002 communication from SPO to Attorney Goldberg in reply to Attorney Goldberg’s previous communications of September 20th, and 24th, 2002, concerning the non-final Office action.

7. SPO and Reed Smith’s Records regarding Abandonment of the Application

Petitioner states that SPO never received a Notice of Abandonment for the present application. No such assertion has been made with respect to the attorney of record, Attorney Goldberg. In fact, Reed Smith’s records show not only that the application was abandoned, but also that a petition to revive the application had been filed.

8. Letters between Reed Smith and SPO

The petition also includes copies of letters between Reed Smith and SPO as follows:

In a letter dated July 31, 2002 Attorney Goldberg mailed a copy of the Office action to SPO, Mr. Suda, and informed Mr. Suda of the statutory response dates with and without extensions of time.

In response to receipt of the letter and Office action, in a letter dated September 12, 2002, SPO thanked Attorney Goldberg for his letter of July 31, 2002, and for the Office action concerning the present application, and directed Attorney Goldberg as follows: “In advance of responding to the Patent Office Action....” The remainder of the letter has been redacted, save the last sentence

where Mr. Suda states : “Your comment on the above would be appreciated by September 16, 2002.”

On September 20, 2002, Ms. Suda at SPO sent a letter to Mr. Goldberg via facsimile wherein Mr. Suda wrote: “Further to our letter of September 12, 2002 and our reminder of September 19, 2002, w,” the remainder of the paragraph and the following paragraph have been redacted. In the last line of the letter Mr. Suda requests: “Please acknowledge this letter by return facsimile.”

Attorney Goldberg/Reed Smith then responded via facsimile to SPO’s September 12, 2002 letter on September 20, 2002. In the letter, Attorney Goldberg writes: “Thank you for your facsimile of September 12, 2002.” Mr. Goldberg also states that “I have reviewed your letter....” The remainder of the letter has been redacted.

Petitioner concludes that the individuals and parties material to maintaining the pendency of the application believed the entire time that the application was pending before this Office. Id.

9. The Declaration of Attorney Goldberg

A review of the Declaration of Mr. Goldberg reveals that Mr. Goldberg has provided no information or commentary on the letter of July 31, 2002, wherein Mr. Goldberg wrote to Mr. Suda and enclosed the Office action, and informed Mr. Suda that the Office actions must be responded to within the six (6) month statutory period, or the letter of September 20, 2002, wherein Mr. Goldberg thanked Mr. Suda for his facsimile of September 12, 2002, and informed Mr. Suda that he had reviewed his letter. Mr. Goldberg recalls with clarity events occurring prior to the Office action’s mailing, and events after the Office action’s mailing; however, Mr. Goldberg has not provided any information as to his recollection of the contents of the communications between himself and Mr. Suda regarding whether to respond to the Office action and/or to continue prosecution of the present application; no information as to whether he was aware of the abandoned status of the application or receipt of the Notice of Abandonment, or any information as to the reference to a February 6, 2003 petition for revival of the present application contained in Reed Smith’s records.

10. The Declaration of Mr. Suda

A review of the Declaration of Mr. Suda reveals that Mr. Suda likewise recalls with clarity events occurring prior to the Office action’s mailing, and events after the Office action’s mailing; however, Mr. Suda provides no information or commentary on the letter dated September 12, 2002, thanking Mr. Goldberg for his letter of July 31, 2002, which contained the Office action, and wherein Mr. Suda stated to Mr. Goldberg that “[i]n advance of responding to the Patent Office Action,” or on the letter to Mr. Goldberg dated September 20, 2002, wherein Mr. Suda stated “[f]urther to our letter of September 12, 2002 and our reminder of September 19, 2002, w,” the remainder of the letter has been redacted, save the last sentence requesting that Mr. Goldberg acknowledge receipt of the letter via facsimile. Nor has Mr. Suda provided any

information as to the seven back and forth communications between SPO and the SUMCO IP Department following the mailing of the Office action on July 3, 2002.

Applicable Law, Rules and MPEP

A grantable petition pursuant to this paragraph must be accompanied by:

- (1) The reply required to the outstanding Office action or notice, unless previously filed;
- (2) The petition fee as set forth in § 1.17(m);
- (3) A statement that the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to this paragraph was unintentional. The Director may require additional information where there is a question whether the delay was unintentional; and
- (4) Any terminal disclaimer (and fee as set forth in § 1.20(d)) required pursuant to paragraph (d) of this section.

As to item (3), additional information is required. The MPEP provides:

The MPEP provides:

The Office does not generally question whether there has been an intentional or otherwise impermissible delay in filing an initial petition pursuant to 37 CFR 1.137(a) or (b), when such petition is filed: (A) within 3 months of the date the applicant is first notified that the application is abandoned; and (2) within 1 year of the date of abandonment of the application. Thus, an applicant seeking revival of an abandoned application is advised to file a petition pursuant to 37 CFR 1.137 within 3 months of the first notification that the application is abandoned to avoid the question of intentional delay being raised by the Office (or by third parties seeking to challenge any patent issuing from the application).

Where a petition pursuant to 37 CFR 1.137(b) is not filed within 1 year of the date of abandonment of the application (note that abandonment takes place by operation of law, rather than by the mailing of a Notice of Abandonment), the Office may require:

- (A) further information as to when the applicant (or the applicant's representative) first became aware of the abandonment of the application; and
- (B) a showing as to how the delay in discovering the abandoned status of the application occurred despite the exercise of due care or diligence on the part of the applicant (or applicant's representative).

To avoid delay in the consideration of the merits of a petition under 37 CFR 1.137(b) in instances in which such petition was not filed within 1 year of the date of abandonment of the application, applicants should include:

- (A) the date that the applicant first became aware of the abandonment of the application; and
- (B) a showing as to how the delay in discovering the abandoned status of the application occurred despite the exercise of due care or diligence on the part of

the applicant.

In either instance, applicant's failure to carry the burden of proof to establish that the "entire" delay was "unavoidable" or "unintentional" may lead to the denial of a petition under 37 CFR 1.137(a) or 37 CFR 1.137(b), regardless of the circumstances that originally resulted in the abandonment of the application.

The MPEP also notes:

Where the applicant deliberately permits an application to become abandoned (e.g., due to a conclusion that the claims are unpatentable, that a rejection in an Office action cannot be overcome, or that the invention lacks sufficient commercial value to justify continued prosecution), the abandonment of such application is considered to be a deliberately chosen course of action, and the resulting delay cannot be considered as "unintentional" within the meaning of 37 CFR 1.137(b). See *In re Application of G*, 11 USPQ2d 1378, 1380 (Comm'r Pat. 1989). An intentional course of action is not rendered unintentional when, upon reconsideration, the applicant changes his or her mind as to the course of action that should have been taken. See *In re Maldague*, 10 USPQ2d 1477, 1478 (Comm'r Pat. 1988).

A delay resulting from a deliberately chosen course of action on the part of the applicant does not become an "unintentional" delay within the meaning of 37 CFR 1.137(b) because:

- (A) the applicant does not consider the claims to be patentable over the references relied upon in an outstanding Office action;
- (B) the applicant does not consider the allowed or patentable claims to be of sufficient breadth or scope to justify the financial expense of obtaining a patent;
- (C) the applicant does not consider any patent to be of sufficient value to justify the financial expense of obtaining the patent;
- (D) the applicant does not consider any patent to be of sufficient value to maintain an interest in obtaining the patent; or
- (E) the applicant remains interested in eventually obtaining a patent, but simply seeks to defer patent fees and patent prosecution expenses.

Likewise, a change in circumstances that occurred subsequent to the abandonment of an application does not render "unintentional" the delay resulting from a previous deliberate decision to permit an application to be abandoned. These matters simply confuse the question of whether there was a deliberate decision not to continue the prosecution of an application with why there was a deliberate decision not to continue the prosecution of an application.

In either instance, applicant's failure to carry the burden of proof to establish that the "entire" delay was "unavoidable" or "unintentional" may lead to the denial of a petition under 37 CFR 1.137(a) or 37 CFR 1.137(b), regardless of the circumstances that originally resulted in the abandonment of the application.

Finally, the MPEP notes:

While the Office reserves the authority to require further information concerning the cause of abandonment and delay in filing a petition to revive, the Office relies upon the applicant's duty of candor and good faith and accepts the statement that "the entire delay in filing the required reply from the due date for the reply until the filing of a grantable petition pursuant to 37 CFR 1.137(b) was unintentional" without requiring further information in the vast majority of petitions under 37 CFR 1.137(b). This is because the applicant is obligated under 37 CFR 10.18 to inquire into the underlying facts and circumstances when a practitioner provides this statement to the Office. In addition, providing an inappropriate statement in a petition under 37 CFR 1.137(b) to revive an abandoned application may have an adverse effect when attempting to enforce any patent resulting from the application. See *Lumenyte Int'l Corp. v. Cable Lite Corp.*, Nos. 96-1011, 96-1077, 1996 U.S. App. LEXIS 16400, 1996 WL 383927 (Fed. Cir. July 9, 1996)(unpublished)(patents held unenforceable due to a finding of inequitable conduct in submitting an inappropriate statement that the abandonment was unintentional). Even if the Office requires further information in a petition under 37 CFR 1.137(b), such petition is still significantly less burdensome to prepare and prosecute than a petition under 37 CFR 1.137(a). The Office is almost always satisfied as to whether "the entire delay...was unintentional" on the basis of statement(s) by the applicant or representative explaining the cause of the delay (accompanied at most by copies of correspondence relevant to the period of delay).

Analysis

The letters between SPO and Attorney Goldberg demonstrate that each was integrally involved in the prosecution of the application. Attorney Goldberg advised SPO of the Office action and of the reply due dates. SPO acknowledged receipt of the letter and Office action, and in the letter dated September 12, 2002, directed Attorney Goldberg to delay in responding to the Office action until some other action was taken when Mr. Suda wrote: "In advance of responding to the Patent Office Action..." The action(s) instructed has been redacted so that it is not possible to determine whether the delay in responding to the Office action was unintentional. Attorney Goldberg/Reed Smith then responded to SPO's September 12, 2002 letter on September 20, 2002. In the letter, Attorney Goldberg writes: "Thank you for your facsimile of September 12, 2002." Mr. Goldberg also states that "I have reviewed your letter..." There was a follow-up letter from SPO to Mr. Goldberg regarding the Office action on September 20, 2002 wherein Mr. Suda wrote: "Further to our letter of September 12, 2002 and our reminder of September 19, 2002, w," the remainder of the paragraph and the following paragraph have been redacted. In the last line of the letter Mr. Suda requests: "Please acknowledge this letter by return facsimile."

A review of the correspondence between Mr. Suda at SPO and Mr. Goldberg at Reed Smith reveal an attentiveness to the status of the present application at the time the response to the Office action was due. Mr. Suda requested that Mr. Goldberg take action in advance to responding to the Office action, and that Mr. Goldberg comment on the action; however, because the information regarding the action to be taken regarding the Office action has been redacted, it is not possible to determine whether the delay in responding to the Office action was unintentional. Moreover, neither Mr. Suda nor Mr. Goldberg have provided any information as to the communications between them in September 2002, or any subsequent communications regarding whether to continue and/or delay prosecution of the application.

Further to this, there have been at least seven back and forth communications between SPO and the SUMCO IP Department following the mailing of the Office action; however, no copies of any communications from SUMCO IP Department to SPO have been provided, nor do any of the principal parties: Mr. Suda or Mr. Goldberg, provide any information as to these communications so that it is not possible to determine whether the delay in responding to the Office action was unintentional¹.

Moreover, Petitioner must provide a showing as to how the delay in discovering the abandoned status of the application occurred despite the exercise of due care or diligence on the part of the applicant. Reed Smith records show that the Office action and Notice of Abandonment were received, and that a petition to revive the present application was filed; however, no information as to how the delay in discovering the abandoned status of the application occurred despite the exercise of due care or diligence on the part of Applicant's duly appointed representative, Reed Smith. The record reveals attention to the status of the application and open line of communication between Mr. Suda and Reed Smith up to the abandonment of the application. Thereafter, according to the record presented in the present petition, the two ceased to communicate regarding this application until 2008. Neither Mr. Goldberg nor Mr. Suda provide any information as to how the delay in discovering the abandoned status of the application occurred despite the exercise of due care or diligence on their part.

Conclusion

The petition is dismissed without prejudice. Applicant should file a request for reconsideration of petition and include the necessary showing, that the abandonment of the application was unintentional, and how the delay in discovering the abandoned status of the application occurred despite the exercise of due care or diligence on the part of the applicant.

Further correspondence with respect to this matter should be addressed as follows:

¹ It is noted that Mr. Takeuchi has been the General Manager of the IP Department since April 2008, and is therefore not in a position to state, as a matter of firsthand knowledge, whether the abandonment of the application in October 4, 2002, was unintentional.

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